APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,883	12/15/2000	Katherine E. Hayes	D/A0625 XER 2 0383	2201

7590 03/30/2006	EXAMINER
Albert P. Sharpe, III, Esq. Fay, Sharpe, Fagan, Minnich & McKee, LLP 1100 Superior Avenue, 7th Floor Cleveland, OH 44114-2518	EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
	Office Action Summary	09/737,883	HAYES, KATHERINE E.
		Examiner	Art Unit	
		Saeid Ebrahimi-dehKordy	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 September 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-18 and 20-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-18 and 20-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

RESPONSE TO THE PRE-APPEAL BRIEF REVIEW

A conference has been held. The rejection is withdrawn and a new office action will be

mailed.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-6, 8-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rosenlund et al (U.S. patent 6,738,155) in view of Jebens et al (Pub. No.: US

20010002204)

Regarding claim 1 Rosenlund et al disclose: A method for determining a location of an image

referenced within a stream of document data the method comprising:

Finding a comment within the data stream (please note column 13 lines 8-20 and

specifically lines 18-20 where postscript file was presented with the comments being

imbedded within) and determining a location of the image stored using a second system

(please note HSM and database 1014 which is used and the second system for locating

the location and file name and path of the files, column 14 lines 33-50) different form the

first (please note column 7 lines 15-27 where the first system "the end user facility is

used for storing the original data) as a function of the comment (please note column 13

lines 18-26). However Rosenlund et al do not clearly disclose: Prescanning the data

stream for verifying the image exists at the location. On the other hand Jebens et al

disclose: Prescanning the data stream for verifying the image exists at the location (note

Fig.7a where the image date is prescaned or searched using the search parameters to

locate the images, page 7, paragraphs, 0059-0060, and paragraph 0063) Therefore it

would have been obvious to a person of ordinary skill in art at the time of the invention

to modify Rosenlund et al's invention according to the teaching of Jebens et al, where

Jebens et al in the same filed of endeavor teach the way the search is conducted to

locate and download the necessary images.

Regarding claim 2 Rosenlund et al disclose: The method for determining a location of

the image as set forth in claim 1, wherein: the finding step includes: identifying as a

function of the comment a reference to the image within the data stream (please note

column 13 lines 18-22) and the determining step includes: determining the location of

the image as a function of the reference (please note column 13 lines 18-25).

Regarding claim 3 Rosenlund et al disclose: The method for determining a location of

the image as set forth in claim 1, wherein the determining step includes:

Identifying a potential mapping to a potential location of the image (please note column

14 lines 33-40).

Regarding claim 4 Rosenlund et al disclose: The method for determining a location of

the image as set forth in claim 3, further including: identifying an additional potential

mapping to an additional potential location of the image (please note column 16 lines

50-65).

Regarding claim 5 Rosenlund et al disclose: The method for determining a location of

the image as set forth in claim 1, wherein the determining step includes:

Identifying a potential search path to a potential location of the image (please note column 17 lines 17-49)

Regarding claim 6 Rosenlund et al disclose: The method for determining a location of the image as set forth in claim 5, further including: identifying an additional search path to an additional potential location of the image (please note column 17 lines 28-42).

Regarding claim 8 Rosenlund et al disclose: The method for determining a location of the image as set forth in claim 1, further including if the original data does not exist at the potential location: manually entering a location of the image and prescanning the data stream for verifying the manually entered location of the image (please note column 10 lines 63-67 and column 11 lines 1-9).

Regarding claim 9 Rosenlund et al disclose: The method for determining a location of data as set forth in claim 1, further including: gathering the image at a local location (please note column 7 lines 14-27).

Regarding claim 10 Rosenlund et al disclose: A method for outputting publication data to an output medium via an output device (please note column 16 lines 50-65) the method comprising at least one of: comparing a comment within the publication data to path mappings to identify a potential pathname of data for an object within the Publication data (please note column 16 lines 51-58) and comparing the comment to search paths to identify the potential pathname of the object data within the publication data (please note column 14 lines 33-41) substituting the verified pathname for the comment in the publication data; retrieving the data based on the verified pathname and inserting the object data into the publication data; and outputting the publication data to

the output medium via the output device; However Rosenlund et al do not clearly

disclose: prescanning the publication data for verifying the potential pathname. On the

other hand Jebens et al disclose: prescanning the publication data for verifying the

potential pathname (note Fig.7a where the image date is prescaned or searched using

the search parameters to locate the images, page 7, paragraphs, 0059-0060, and

paragraph 0063) Therefore it would have been obvious to a person of ordinary skill in

art at the time of the invention to modify Rosenlund et al's invention according to the

teaching of Jebens et al, where Jebens et al in the same filed of endeavor teach the

way the search is conducted to locate and download the necessary images.

Regarding claim 11 Rosenlund et al disclose: The method for outputting publication

data as set forth in claim 10, further including: gathering the output data for the object

onto a local memory device (please note column 7 lines 29-51)

Regarding claim 12 Rosenlund et al disclose: The method for outputting publication

data as set forth in claim 10, further including: predefining the path mappings and

search paths (please note column 14 lines 33-40).

Regarding claim 13 Rosenlund et al disclose: The method for outputting publication

data as set forth in claim 10, further including: if the potential pathname is not verified in

the rescanning step prompting a user to manually enter the potential pathname (please

note column 14 lines 33-35).

Regarding claim 14 Rosenlund et al disclose: The method for outputting publication

data as set forth in claim 13, further including: after the potential pathname is manually

entered, rescanning the publication data (please note column 11 lines 24-31).

Regarding claim 15 Rosenlund et al disclose: The method for outputting publication data as set forth in claim 10, wherein the outputting step includes: outputting the publication data within a xerographic environment (please note column 7 lines 52-65).

Regarding claim 16 Rosenlund et al disclose: A system for outputting a high-resolution version of an image on a medium (please note column 10 lines 38-48) comprising: a processing device for identifying, as a function of at least one of a) a mapping and b) a search path and as a function of a comment representing a low-resolution version of the image (please note column 13 lines 18-23 and also column 14 lines 34-50) a storage location within a processing network (please note column 6 lines 4-14) data corresponding to a high-resolution version of the image being saved at the storage location (please note column 6 lines 12-14) and an output device (please note Fig.1 item 400 the printer) communicating with the processing device (please note Fig.1 where the printing facility is communicating with the local network and public network, column 4 lines 25-55) and for producing the high-resolution version of the image on the medium as a function of the data saved at the storage location (please note column 10 lines 30-49 and also column 14 lines 33-50) However Rosenlund et al do not disclose: wherein the processing device rescans data corresponding to the high-resolution version of the image. On the other hand Jebens et al disclose: wherein the processing device prescans data corresponding to the high-resolution version of the image (note Fig.7a where the image date is prescaned or searched using the search parameters to locate the images, page 7, paragraphs, 0059-0060, and paragraph 0063 where the search is done to locate and download the copies of the selected data files including the

low resolution of the image files) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Rosenlund et al's invention according to the teaching of Jebens et al , where Jebens et al in the same filed of endeavor teach the way the search is conducted to locate and download the necessary images.

Regarding claim17 Rosenlund et al disclose: The system for outputting a high-resolution version of an image as set forth in claim 16, wherein the processing device substitutes an identifier of the storage location of the high-resolution version of the image for an identifier of a storage location of the low-resolution version of the image (please note column 10 lines 31-49).

Regarding claim 18 Rosenlund et al disclose: The system for outputting a high-resolution version of an image as set forth in claim 16, wherein a user previously enters the mapping and the search path (please note column 14 lines 33-44).

Regarding claim 20 Rosenlund et al disclose: The system for outputting a high-resolution version of an image as set forth in claim 16, wherein before the output device produces the high-resolution version of the image the processing device gathers the data corresponding to the high-resolution version of the image to a local storage location (please note column 14 lines 26-41).

Regarding claim 21 Rosenlund et al disclose: The system for outputting a high-resolution version of an image as set forth in claim 16, wherein the output device operates within a xerographic environment (please note column 7 lines 52-65).

Regarding claim 22 Rosenlund et al disclose: the system of outputting a high-resolution version an image as set forth in claim 16, wherein said processing network is a first processing network, and wherein said high-resolution version of the image being saved at the storage location is within a second processing network different from the first (please note column 13 lines 18-26)

Contact Information

➢ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for *formal* communications; please mark
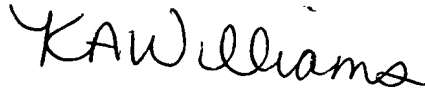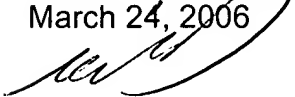**"EXPEDITED PROCEDURE")**

Or:

(703) 306-5406 (for *informal* or *draft* communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
March 24, 2006

**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**